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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,557	08/25/2000	Christian Devaux	COMA-037/00US	5736

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EXAMINER

PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 10/02/2002 10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/648,557

Applicant(s)

DEVAUX ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 and 19-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Office Action

Status of the Claims

1. Applicants' election with traverse of Group I (claims 1-10 and 18) in Paper No. 9 is acknowledged. The traversal is based upon the argument that the inventions of Groups I-IV are not independent and that it would not be a serious burden on the examiner to
5 examine all the groups concomitantly. Establishment of *prima facie* evidence for a serious burden requires the demonstration, by appropriate explanation, of either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. § 808.02. The following items adduce a *prima*
10 *facie* showing of burden:

1) The inventions of Groups I-IV display both separate classifications and a separate status in the art as set forth in the last Office action.

2) The inventions of Groups I-IV are directed towards independent
15 and distinct inventions as previously set forth in paper no. 8 wherein the following explanation was provided:

2. Inventions II and III/IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they
20 have different functions, or they have different effects (refer to M.P.E.P. ¶s 806.04 and 808.01). In the instant case, the methodologies of Groups III and IV neither require nor use the composition of Group II. Accordingly, each invention is clearly drawn toward a different inventive entity.

3. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have
25 different functions, or they have different effects (refer to M.P.E.P. ¶s 806.04 and 808.01). In the instant case, each of the
30 identified groups is directed toward a different methodology that

accomplishes different scientific objectives and employs different scientific reagents and assay steps. Therefore, each invention is clearly drawn toward a different inventive concept.

5 4. Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially
10 different process of using that product (M.P.E.P. ¶ 806.05(h)). In the instant case, the peptides of Group I can be employed in a materially different process such as the generation of immunological reagents (i.e., polyclonal or monoclonal antisera). Moreover, the methodology of Group IV can use materially different products such
15 as protease inhibitors.

5. Inventions I and III are related as product made and process of making. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can
20 be used to make other and materially different products, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. ¶ 806.05(f)). In the instant case, the pharmaceutical can be produced by a number of methodologies such as solid-state peptide synthesis or through the use of recombinant
25 means.

6. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.
30 In the instant case, both inventions have separate utilities. For instance, the peptides can be employed in the generation of immunological reagents (i.e., polyclonal and monoclonal antibodies) while the vector can be utilized to deliver various compounds to a cell of interest. See M.P.E.P. ¶ 806.05(d).

35 Accordingly, each invention will generate unique issues regarding

novelty, patentability, and enablement.

3) Since the inventions disclosed *supra* are directed towards patentably distinct material, a search for one invention would not necessarily result in the identification of art that is concomitant with that required to address the issues generated by the other inventions. Applicants' arguments have been thoroughly considered but are not deemed persuasive for the reasons set forth *supra* and in the original restriction requirement. **The requirement is still deemed to be proper and is therefore made FINAL.** Claims 11-17 and 19-30 are withdrawn from further consideration by the examiner, pursuant to 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

2. The information disclosure statement filed 28 November, 2000, has been placed in the application file and the information referred to therein has been considered.

35 U.S.C. § 112, First Paragraph

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-10 and 18 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *In re Rasmussen*, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). *In*

re *Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976). The claims are directed toward peptidic inhibitors or analogs comprising a decapeptide. The only structural stipulation is that a basic amino acid residue must be present in position 1, an acidic amino acid in positions 2 and 5, and tryptophan in positions 4, 7, and 8. Thus, the claims encompass a large genus of peptides bearing various conservative and non-conservative substitutions.

The written description requirement under Section 112, first paragraph, stipulates that the claimed subject matter must be supported by an adequate written description that is sufficient to enable anyone skilled in the art to make and use the invention. The courts have decided that the specification must demonstrate that the inventor had possession of the claimed invention as of the filing date relied upon. Although the claimed subject matter need not be described identically, nonetheless, the disclosure relied upon must convey to those skilled in the art that applicants had invented the subject matter claimed. *Ralston Purina Company v. Far-Mar-Co., Inc.*, 227 U.S.P.Q. 177 (C.A.F.C. 1985). *In re Wilder, et al.*, 222 U.S.P.Q. 369 (C.A.F.C. 1984). *In re Wertheim, et al.*, 191 U.S.P.Q. 90 (C.C.P.A. 1976). *In re Blaser, Germscheid, and Worms*, 194 U.S.P.Q. 122 (C.C.P.A. 1977). *In re Driscoll*, 195 U.S.P.Q. 434 (C.C.P.A. 1977). *Utter v. Hiraga*, 6 U.S.P.Q.2d 1709 (C.A.F.C. 1988). *University of California v. Eli Lilly*, 119 F.3d 1559, 43 U.S.P.Q.2d 1398 (Fed. Cir. 1997). *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 U.S.P.Q.2d 1016-1031 (C.A.F.C. 1991). *Fiers v. Sugano*, 25 U.S.P.Q.2d 1601-1607 (C.A.F.C. 1993). *In re Bell*, 26 U.S.P.Q.2d 1529-1532 (C.A.F.C. 1993). *In re Deuel*, 34 U.S.P.Q.2d 1210-1216 (C.A.F.C. 1995).

Moreover, where claims directed toward chemical compounds (e.g., nucleic acids and proteins) are concerned, legal precedence also clearly dictates that conception of a chemical compound (e.g., a DNA molecule) is not achieved until reduction to practice has

occurred (*University of California v. Eli Lilly*, 119 F.3d 1559, 43 U.S.P.Q.2d 1398 (Fed. Cir. 1997); *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 U.S.P.Q.2d 1016-1031 (C.A.F.C. 1991); *Fiers v. Sugano*, 25 U.S.P.Q.2d 1601-1607 (C.A.F.C. 1993); *In re Bell*, 26 U.S.P.Q.2d 1529-1532 (C.A.F.C. 1993); *In re Deuel*, 34 U.S.P.Q.2d 1210-1216 (C.A.F.C. 1995)). In *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.* the court concluded that "It is not sufficient to define it solely by its principal biological property, e.g., encoding human erythropoietin, because an alleged conception having no more specificity than that is simply a wish to know the identity of any material with that biological property. We hold that when an inventor is unable to envision the detailed constitution of a gene so as to distinguish it from other materials, as well as a method for obtaining it, conception has not been achieved until reduction to practice has occurred, i.e., until after the gene has been isolated."

Perusal of the disclosure by the skilled artisan would lead one to conclude that applicants were not in possession of the multitude of peptidic inhibitors currently being claimed. The disclosure does not describe the preparation of a reasonable number of peptidic species. The disclosure fails to provide a detailed description of the molecular determinants modulating the antiviral properties of these various compounds. An inordinate number of substitutions are permitted within any given decapeptide. However, the disclosure fails to adequately describe the salient characteristics of any given antiviral peptide. Thus, the claimed invention is nothing more than an attempt by applicants to procure subject matter to which they are not entitled.

Correspondence

5. Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette,

1096 OG 30 (November 15, 1989). Official communications should be directed toward one of the following Group 1600 fax numbers: (703) 308-4242 or (703) 305-3014. Informal communications may be submitted directly to the Examiner through the following fax number: (703) 308-4426. Applicants are encouraged to notify the Examiner prior to the submission of such documents to facilitate their expeditious processing and entry.

6. Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-2227. The examiner can normally be reached Monday through Thursday from 8:30 AM to 6:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, James Housel or Laurie Scheiner, can be reached at (703) 308-4027 or (703) 308-1122, respectively. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Respectfully,

Jeffrey S. Parkin, Ph.D.
Patent Examiner
Art Unit 1648

30 September, 2002